



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,396	02/20/2004	Tony M. Pearce	5127 P	6439

7590 10/12/2006

Daniel P. McCarthy  
Parsons Behle & Latimer  
201 South Main Street, Suite 1800  
P.O. Box 45898  
Salt Lake City, UT 84111

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT PAPER NUMBER

1722

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,396

Applicant(s)

PEARCE ET AL.

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 6, 10, 11, 13-19, 21, 22, 26-30, 32, 34-40, 42-48, 50-52 and 54-60 is/are allowed.
- 6) ☒ Claim(s) 4, 7, 8, 12, 20, 23-25, 33, 41, 49 and 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Art Unit: 1722

1. Applicant's election of Group I (claims 1-8, 10-30 and 32-60) in the reply filed on 14 July 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP 818.03(a).

2. The priority information as stated in the first line of the specification contains errors.

U.S. Ser. No. 09/303,919 - U.S. Pat. No. 6,413,458 is claimed for priority. This application number and patent do not correspond. Instead, it appears that U.S. Ser. No. 09/303,979 should be the application number claimed (which corresponds to U.S. Pat. No. 6,413,458).

The priority claims also recites, "United States Patent Application Serial No. 08/601,374 filed on February 14, 1996, now U.S. Patent No. 5,749,111, which is a continuation-in-part of United States Patent Application No. 08/784,413, filed on January 10, 1997, now U.S. Patent No. 5,994,450[.]" This must be an error as the earlier filed application is recited as claiming priority to a later filed application. Appropriate clarification and correction is required.

Art Unit: 1722

3. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 7, 8, 12, 20, 23-25, 33, 41, 49 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 7, 8, 12, 20, 23, 24, 25, 33, 41, 49 and 53 are defined as depending on non-existent claims. Claim 4, for example, is recited as depending from "claim 0." As such, these claims are indefinite.

5. Claims 1-3, 5, 6, 10, 11, 13-19, 21, 22, 26-30, 32, 34-40, 42-48, 50-52 and 54-60 are allowed.

6. Claims 4, 7, 8, 12, 20, 23-25, 33, 41, 49 and 53 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action.

Art Unit: 1722

7. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a method for producing a cushioning element as defined in the claims of the instant application. The closest prior art is disclosed by Abrams et al. (U.S. Pat. No. 6,620,353); Malone (U.S. Pat. No. 5,124,097); Meyers (U.S. Pat. No. 3,792,951); and Kawamura (U.S. Pat. No. 3,274,315).

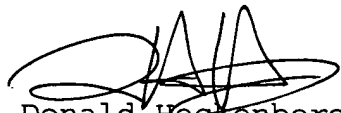
Abrams and Malone both disclose a conventional methods of molding using extruders. Neither of the reference teaches or suggests the provision of forming rods in the aperture of the extruder. Kawamura and Meyers also disclose molding using extruders which provide partially hollow products. Neither reference, however, is directed a making cushioning elements, and thereby fails to teach or suggest working with gels as defined in the claims of the instant application.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

Art Unit: 1722

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
Primary Examiner  
A.U. 1722

10-2-6